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EXAMINER

SHARON, AYAL I

ART UNIT

PAPER NUMBER

2123

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5

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/751,970

Applicant(s)

TVEIT ET AL.

Examiner

Ayal I Sharon

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25 and 28-45 is/are rejected.
- 7) ☒ Claim(s) 24, 26 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Introduction***

1. Claims 1-45 of U.S. Application 09/751,970 filed on 12/29/2000 are presented for examination.

### ***Allowable Subject Matter***

2. Claims 24, 26, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and all intervening claims, and if the base and intervening claims were to be amended so as to overcome all of their rejections.

### ***Claim Objections***

3. Claims 29-31 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.
4. Claim 35 is objected to because of the following informalities: the term "(3)" at the end of the claim. Appropriate correction is required.

***Claim Interpretations***

5. For the purposes of examination, Examiner has interpreted the term "and/or" in Claims 1, 8, 13, 19, 25, 28, 42, and 45 as being equivalent to "or".

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-18 and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the limitation in Claim 1: "making an assessment of the condition of said apparatus ..." lacks the required written description. All dependent claims inherit this defect.
9. **Claims 1-18 and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention. In particular, the limitation in Claim 1: "making an assessment of the condition of said apparatus ..." was not described in the specification in such a way as to enable one skilled in the art to make the invention. All dependent claims inherit this defect.

**10. Claims 1-18, 20, 31, 36, and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

11. Claim 1 recites the limitation "said help desk" in line 8. There is insufficient antecedent basis for this limitation in the claim. All dependent claims inherit this defect.

12. Claim 7 recites the limitation "... that the plan ...". There is insufficient antecedent basis for the limitation in this claim

13. Claim 31 uses the indefinite language "... associated with an [sic] type of industrial plant as diverse as ...". It is unclear whether the limitations following the phrase are part of the claimed invention.

14. Regarding claims 1, 13-15, 20, 36, and 38-39, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**15. Claims 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

16. Claims 29-31 provides for the use of a system, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.
17. The specification regarding the claimed invention is deficient in the areas cited above. Accordingly, the examiner has made prior art rejections based on the limited scope of information contained in the specification for supporting the claims. The rejections are complete and specifically applied against the claims based on this limited disclosure.

***Claim Rejections - 35 USC § 101***

18. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 19. Claims 1-18 and 37-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are not restricted to the technological arts.**

20. The limitations of Claim 1, "having the inspector/repairman examine ...", "receiving at said help desk ...", "finding stored information ...", "comparing said stored information ..." and "making an assessment ..." are not limited to the technological arts. All dependent claims inherit this defect.

21. The limitation of Claim 2, "... making a decision for the repairman ..." is not limited to the technological arts.

22. The limitation of Claim 3, "... the inspector/repairman carries out a temporary repair ..." is not limited to the technological arts.

23. The limitation of Claim 4, "... the repair carried out is documented by inspector/repairman in consultation ..." is not limited to the technological arts.

24. The limitation of Claim 5, "... the inspector/repairman in consultation with the Help Desk makes a plan to repair a fault at a later time ..." is not limited to the technological arts.

25. The limitation of Claim 6, "... the inspector/repairman in consultation with the Help Desk documents the plan ..." is not limited to the technological arts.

26. The limitation of Claim 8, "... taking action to place purchase ..." is not limited to the technological arts.

27. The limitation of Claim 9, "... a stop of taking action ..." is not limited to the technological arts.

28. **Claims 29-31 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).**

***Claim Rejections - 35 USC § 102***

29. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

30. The prior art used for these rejections is as follows:

31. Mitchell et al., U.S. Patent 6,574,672. (Henceforth referred to as "**Mitchell**").

32. Leslie, U.S. Patent 6,668,629. (Henceforth referred to as "**Leslie**").

33. The claim rejections are hereby summarized for Applicant's convenience. The detailed rejections follow.

**34. Claims 32-33 and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell.**

35. In regards to Claim 32, Mitchell teaches the following limitations:

32. A computer program product comprising computer code means or software code portions to make a computer or a processor operate in Information System comprising one or more databases and a Help Desk to provide maintenance for an electrical power generation, transmission and distribution system and apparatus connected to said power system, wherein said computer or processor is made to carry out actions to provide maintenance for said power system including to:

receive a data input representing at least one maintenance report,  
(See Mitchell, especially: col.4, line 17 – col.5, line 12)

Examiner finds that the transferred report (col.5, lines 2-5) corresponds to a "maintenance report".

match the data input to an apparatus connected to a Power System network with information stored in a database,  
(See Mitchell, especially: col.4, line 17 – col.5, line 12)



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Examiner finds that that Mitchell's "instructional database" corresponds to the claimed apparatus.

receive a second input documenting a maintenance repair action,  
(See Mitchell, especially: col.4, line 17 – col.5, line 12)

Examiner finds that the transferred report (col.5, lines 2-5) corresponds to a "maintenance report".

link the second documented repair action to the apparatus and network,  
store the documented repair action.  
(See Mitchell, especially: col.4, line 17 – col.5, line 12)

Examiner finds that the transferred report corresponds to a stored document repair action.

36. In regards to Claim 33, Mitchell teaches the following limitations:

33. A computer program product according to Claim 32, which comprises software means for carrying out a further action to:  
update status reports for the apparatus and network.  
(See Mitchell, especially: col.4, line 17 – col.5, line 12)

Examiner finds that that the sending and receiving of data (col.5, lines 8-12) correspond to "update[d] status reports".

37. In regards to Claim 35, Mitchell teaches the following limitations:

35. A computer program product according to Claim 32, which comprises software means for carrying out a further action to:  
send a signal comprising details for work orders dependent on the documented repair action to a maintenance Service Provider company (3).  
(See Mitchell, especially: col.4, line 17 – col.5, line 12)

Examiner interprets that the user / repairman taught by Mitchell is a representative of a maintenance service provider company.

38. In regards to Claim 36, Mitchell teaches the following limitations:

36. The computer program code element of Claim 32, which comprises computer code means or software code portions including executable parts formed written as one or more object oriented programs and accessible and implementable over a network such as the Internet.  
(See Mitchell, especially: col.4, line 17 – col.5, line 12)

39. In regards to Claim 37, Mitchell teaches the following limitations:

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37. A computer program contained in a computer readable medium, comprising computer program code means to make a computer or processor carry out the steps according to any of Claims 1-18 or Claims 32-36.

(See Mitchell, especially: col.4, line 17 – col.5, line 12)

**40. Claims 40-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Leslie.**

41. In regards to Claim 40, Leslie teaches the following limitations:

40. A first computer data signal embodied for communication in a computerised system. the communication being associated with maintenance of an apparatus of a system for electrical power generation, transmission, and distribution, wherein that the first data signal:

is transmitted from a location of said electrical power generation, transmission and distribution system to an information system for said electrical power generation, transmission and distribution system and the first data signal comprises a graphic image representing a condition of said apparatus for maintenance purposes.

(See Leslie, especially: col.2, lines 15-30)

42. In regards to Claim 41, Leslie teaches the following limitations:

41. A second computer data signal embodied for communication in a computerized system, the communication being associated with maintenance of an apparatus of a system for electrical power generation, transmission and distribution, wherein that the second data signal:

is transmitted from an information system for said electrical power generation, transmission and distribution system to a maintenance provider company and comprises information associated with a maintenance specification of said apparatus in the information system regarding a plan to provide maintenance for said apparatus.

(See Leslie, especially: col.2, lines 15-30)

43. In regards to Claim 42, Leslie teaches the following limitations:

42. A computer data signal as claimed in Claim 41, wherein that it is sent to a maintenance provider company and comprises information associated with a maintenance specification of said apparatus a request to purchase spare parts and/or replacement equipment for said apparatus.

(See Leslie, especially: col.2, lines 15-30, and col.6, lines 5-10)

44. In regards to Claim 43, Leslie teaches the following limitations:

43. A computer data signal as claimed in Claim 41, wherein that the information in said data signal comprises at least one part identifying said apparatus and one part identifying sender of the purchase request.

(See Leslie, especially: col.2, lines 15-30, and col.6, lines 5-10)

45. In regards to Claim 44, Leslie teaches the following limitations:

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44. A computer data signal as claimed in Claim 41, wherein that the computer data signal is generated by an automatic maintenance providing procedure of the information system.  
(See Leslie, especially: col.2, lines 15-30, and col.6, lines 5-10)

46. In regards to Claim 45, Leslie teaches the following limitations:

45. A computer data signal as, claimed in Claim 41, wherein that the computerized system is adapted to create and send a purchase order to purchase, based on the computer data signal, spare parts and/or replacement equipment.  
(See Leslie, especially: col.2, lines 15-30, and col.6, lines 5-10)

### ***Claim Rejections - 35 USC § 103***

47. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

48. The prior art used for these rejections is as follows:

49. Fedirchuk et al., U.S. Patent 6,545,482. (Henceforth referred to as "**Fedirchuk**").

50. Mitchell et al., U.S. Patent 6,574,672. (Henceforth referred to as "**Mitchell**").

51. Leslie, U.S. Patent 6,668,629. (Henceforth referred to as "**Leslie**").

52. The claim rejections are hereby summarized for Applicant's convenience. The detailed rejections follow.

**53. Claims 19-23, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fedirchuk in view of Mitchell.**

54. In regards to Claim 19,

19. A power system information system to provide maintenance for an electrical power generation, transmission and distribution system and apparatus connected to said power system, said Information System comprising one or more databases, and communication links to maintenance personnel located elsewhere, wherein said information system comprises:

Fedirchuk teaches the following limitations:

an engineering/service Help Desk,  
(Fedirchuk, especially: col.2, lines 6-7)

Fedirchuk teaches a "central station arranged for communication to and from each of the [monitoring] units over a communications medium".

communication means at the Help Desk to receive a inspection report comprising a graphic image,  
(Fedirchuk, especially: col.2, lines 6-7 and col.3, lines 5-11)

Fedirchuk teaches a "central station arranged for communication to and from each of the [monitoring] units over a communications medium".

Fedirchuk also teaches that "The captured data can be obtained from multiple recording locations and is automatically time-synchronized so that an overall coordinated snapshot of the power system dynamics is achieved. The wide-area capture is achieved through standard Internet, Intranet, and/or switched telephone network communication links."

Examiner interprets that the "coordinated snapshot" corresponds to the claimed "received graphic image".

display means at the Help desk to examine the report and/or the graphic image,  
(Fedirchuk, especially: col.2, lines 6-7 and col.3, lines 5-11)

Examiner interprets that display means are necessary to view a "coordinated snapshot" and therefore are inherent.

computer and display means to compare the graphic image and/or inspection report with retrieved information.  
(Fedirchuk, especially: col.2, lines 6-7 and col.3, lines 5-11)

Examiner interprets that computer-file storage and retrieval capabilities, and a display, constitute "computer and display means to compare the graphic image ... with retrieved information. The ability to store and retrieve files is inherent to computers, because otherwise they would not work. The display means is also inherent, in order to show the cited "coordinated snapshot".

Fedirchuk, on the other hand, while teaching the use of stationary inspection means that makes a graphic image for an inspection report, does not expressly teach the following limitations:

mobile inspection means to make a graphic image for an inspection report,

mobile terminal, computer and display means to retrieve information from the one or more databases,

----- Mitchell does teach these limitations. Mitchell teaches (col.2, lines 37-48) -----

that "The present invention provides a light, portable hands-off or hands free maintenance and repair system ... that is able to access a task-specific database."

Mitchell also teaches (col.4, lines 41-46) that "Finally, a communications link is provided by which the second computer can send data to and receive data from the wireless station while the user is working on the task within range of the wireless station, permitting audio and/or video teleconferencing between the user and the assistant or supervisor.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Fedirchuk with those of Mitchell, because Mitchell teaches (col.2, lines 30-35) that "For existing systems in the repair and maintenance industry, or within industries in need of highly specialized on-site repair and maintenance personnel, there is presently no system, apparatus or method of providing multimedia data acquisition, interpretation, instruction and reporting."

55. In regards to Claim 20, Fedirchuk teaches the following limitations:

20. A power system information system according to Claim 19, in which the inspection means comprises a web camera arranged to send pictures in a format such as TCP/IP suitable for transmission over a network such as the Internet.  
(Fedirchuk, especially: col.2, lines 21-25)

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Fedirchuk teaches the use of the internet. The use of TCP/IP is necessary for the use of the internet, and is therefore inherent.

56. In regards to Claim 21, Mitchell teaches the following limitations:

21. A power system information system according to Claim 19, which comprises a communication means enabling two-way voice communication between an inspector at a site and the Help Desk.  
(Mitchell, especially: col.4, lines 40-45)

57. In regards to Claim 22, Mitchell teaches the following limitations:

22. A power system information system according to Claim 19, which comprises storage means to document details of a decision to provide maintenance service.  
(Mitchell, especially: col.4, line 66 to col.5, line 12)

58. In regards to Claim 23, Mitchell teaches the following limitations:

23. A power system information system according to Claim 19, which comprises reporting and storage means to document details of a plan to provide maintenance service at a later time.  
(Mitchell, especially: col.4, line 66 to col.5, line 12)

59. In regards to Claim 25, Mitchell teaches the following limitations:

25. A power system information system according to Claim 19, which comprises computer program and/or software means to match a identified apparatus to details of the apparatus stored as files in a database of the system, the files comprising any of text, graphic, interactive multimedia, a sound recording.  
(Mitchell, especially: col.4, line 17 to col.5, line 12)

60. In regards to Claim 28, Fedirchuk teaches the following limitations:

28. A power system information system according to Claim 19, which comprises computer program and/or software means to model and or simulate an effect on the power system of any of the following: a disconnection; a partial disconnection; a reconfiguring or switching in of one part and switching out of another part; an increased load on an equipment; a reduced load on an equipment.  
(Fedirchuk, especially: col.1, lines 22-25)

**61. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Mitchell in view of Leslie.**

62. In regards to Claim 34, Mitchell does not expressly teach the following limitations:

34. A computer program product according to Claim 32, which comprises software means for carrying out a further action to:  
    send a signal in the form of a purchase order comprising details for replacement apparatus of spare parts to a parts supplier.

Leslie, on the other hand, does (see col.6, lines 5-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Mitchell with those of Leslie, because Leslie teaches (col.2, lines 10-13) that "... it would be desirable to provide a web-enabled controller so that operational data can be accessed, retrieved, and controlled through the internet."

### ***Conclusion***

63. The following prior art, made of record and not relied upon, is considered pertinent to applicant's disclosure.

64. Microsoft Press, Computer User's Dictionary, 1998. p.124.

### ***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone number is (703) 306-0297. The examiner can normally be reached on Monday through Thursday, and the first Friday of a biweek, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (703) 305-9704. Any response to this office action should be mailed to:

Director of Patents and Trademarks  
Washington, DC 20231

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Hand-delivered responses should be brought to the following office:

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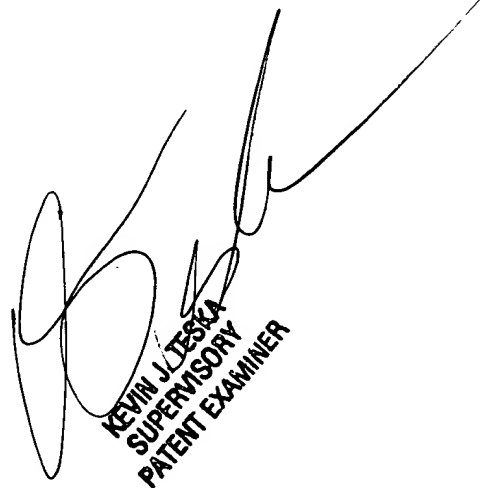
The fax phone number is: (703) 872-9306

Any inquiry of a general nature or relating to the status of this application  
or proceeding should be directed to the receptionist, whose telephone number is:  
(703) 305-3900.

Ayal I. Sharon

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June 10, 2004



KEVIN J. TESKA  
SUPERVISORY  
PATENT EXAMINER